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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,164	06/25/2001	Ryuji Ishiguro	209466US6PCT	9239

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EXAMINER

AL HASHEMI, SANA A

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

**Application No.**

09/869,164

**Applicant(s)**

ISHIGURO ET AL.

**Examiner**

Sana Al-Hashemi

**Art Unit**

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

**Claim Status: 1-17 are pending.**

### *Specification*

The disclosure is objected to because of the following informalities: page 4, line 4, “srorage” is misspelled . Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-7, and 14, 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. [Specifically the claimed subject matter does not recite any tangible subject matter.]

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 2171

Claim 1 is a "single means" claim. (Donaldson does not affect the holding of *In re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) to the effect that a single means claim does not comply with the enablement requirement of 35 U.S.C. 112, First paragraph. As Donaldson applies only to an interpretation of a limitation drafted to correspond to 35 U.S.C. 112, sixth paragraph, which by its terms is limited to "an element in a claim to a combination," it does not affect a limitation in a claim which is not directed to a combination.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It's unclear to one of ordinary skill in the art what the metes and bounds are of the limitation "using condition information stating use condition of each contents data" cited in claim 1 in making or using the invention. Examiner interprets the using condition information stating use condition of each contents data interpretation as privileges of modes of access and copy.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

Art Unit: 2171

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Wiser et al (US Patent No. 6,330,675).

1. Regarding Claims 1, 2, and 3, Wiser discloses a control apparatus for control data for managing one or more contents data and the using condition information stating use conditions of each contents data (see column 3, lines 45-55, Wiser<sup>1</sup>) and for controlling the corresponding contents data based on the using condition information, said apparatus comprising (see column 3, lines 43-59, Wiser):

means for converting said using condition information stated in a pre-set format (see Fig. 2, 214, column 4, lines 34-37, Wiser), into the using condition information of another format having the same contents (see column 3, lines 60-67, Wiser).

2. Regarding Claims 4, 8, 12, and 14, Wiser discloses a data processing apparatus comprising:

one or more application for reproduction for managing one or more contents data and the using condition information stating the using condition of each contents data and for reproducing the contents data based on said using condition information (see column 5, lines 20-34, Wiser<sup>2</sup>); and

a comprehensive contents management unit for managing the contents data and the using condition information of said contents data (see column 5, lines 35-39, wiser);

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<sup>1</sup> Examiner interprets digital audio file as a content data, use condition as an authorization for copying or downloading files.

<sup>2</sup> Examiner interprets the audio file as a content data.

each application for reproduction or the comprehensive contents management unit converting the contents encryption system used by each application and the format of the using condition information into the contents encryption system used by said comprehensive contents management unit and the format of the using condition information to transfer the contents data and the using condition information from the application for reproduction to said comprehensive contents management unit (see column 5, lines 40-60, Wiser).

3. Regarding Claims 5, 9, 13, and 15, Wiser discloses a data processing apparatus wherein each application for reproduction converts the encryption system for contents data transferred to said comprehensive contents management unit from the encryption system used by the application for reproduction to an encryption system used by said comprehensive contents management unit (see column 5, lines 61-67, Wiser).

4. Regarding Claims 6, 10, and 16, Wiser discloses a data processing apparatus wherein said comprehensive contents management unit converts the encryption system for contents data transferred from each application for reproduction from an encryption system used by the application for reproduction to the encryption system used by the comprehensive contents management unit (see column 6, lines 6-15, Wiser); and

wherein the comprehensive contents management unit converts the format for the using condition information transferred from each application for reproduction from a format prescribed by the application for reproduction to a format prescribed by the comprehensive contents management unit (see column 6, lines 16-24, Wiser).

5. Regarding Claims 7, 11, and 17, Wiser discloses a data processing apparatus wherein said comprehensive contents management unit connects to a server over a network by a transfer

Art Unit: 2171

protocol which is the same as the transfer protocol used between the comprehensive contents management unit and each application for reproduction (see Fig. 5, 500, 502, and 504, column 6, lines 42-56, Wiser).

6. Regarding Claim 18, Wiser discloses a recording medium having stored therein a comprehensive contents management software for supervising the first and second contents data and the using condition information stating the using condition of said first and second contents data to supervise the contents data based on said using condition information (see column 7, lines 1-11, Wiser); comprising:

a reception interface for receiving first contents data furnished from a first contents server and second contents data furnished from a second contents server (see column 7, lines 12-17, Wiser);

a using condition conversion program for converting the format of the using condition information employed by said first contents server into the format of the using condition information employed in said comprehensive contents management unit (see column 7, lines 3-42, Wiser);

the format of the using condition information of contents used by said second contents server being the same as the format of the using condition information of the contents used by said comprehensive contents management unit (see column 8, lines 47-57, Wiser);

wherein when transferring said first contents data and the using condition information appended to the first contents data to said comprehensive contents management unit, the format of the using condition information appended to said first contents data is converted into the

Art Unit: 2171

format of the using condition information used by said comprehensive contents management unit (see column 8, lines 57-67, Wiser).

***Other Prior Art Made of Record***

1. Wiser et al. (US Patent No. 6,330,675) discloses a system and method for secure transfer of digital data to a local recordable storage medium.
2. Rhoads et al. (US Patent No. 6,442,285) discloses controlling operation of a device using a re-configurable watermark detector.
3. Van Zoest et al. (US Patent No. 6,496,802) discloses system and a method for providing access to electronic works.



Art Unit: 2171

*Points of Contact*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to: Sana Al-Hashemi whose telephone number is (703) 305-4881. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436. Any response to this office action should be mailed to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231. Or telefax at phone number (703) 746-9890. For formal or draft communications, please label "PROPOSED" or "DRAFT". Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6<sup>th</sup> Floor Receptionist, Arlington, Virginia. 22202.

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Sana Al-Hashemi  
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August 1, 2003



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